REMARKS

The Non-Final Office Action of July 24, 2003 has been fully considered by the Applicants. In view of the above amendments and following remarks, withdrawal of the rejections and issuance of a Notice of Allowance is respectfully requested.

Applicants submit the above amendments do not raise new matter, as support for the amendments may be found in the Application as originally filed. Specifically, support for the amendments to claims 1 and 18 may be found on page 12, lines 1-2 of the specification.

The Examiner has rejected claims 1, 2, 7, 12, and 13 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants respectfully traverse the rejections.

Claims 1, 7, 12, and 13 have been amended to provide proper Markush language. Claim 11 has been amended to correct an inadvertent spelling error in accordance with the suggestion by the Examiner.

Applicants do not understand the Examiner's contention that claim 1 is vague in not suggesting how much the Shore A hardness can be. Claim 1 clearly recites a Shore A hardness less than 30. Applicants respectfully submit this is not vague and request the rejection be withdrawn.

The Examiner has also stated the meaning of "maleimide contributed monomer units" is not clear. According to the Examiner, the block is nothing but a monomer. Applicants submit that one of ordinary skill in the art would recognize that a "monomer unit" is defined as the residue from each monomer in the polymer chain. As such, the "block containing maleimide contributed monomer units" is a polymaleimide block. Applicants respectfully submit no amendment is needed and request withdrawal of the rejection.

Claim 2 has been amended to remove the term "generally."

Claim 13 has been rejected for reciting "carboxyl, formyl, and hydroxyl." Applicants are unsure why the Examiner contends that these terms are vague, as they are IUPAC accepted names for particular functional groups and are understood in the art.

The Examiner has rejected claims 1, 4, 8, 10-15, 18, and 19 under 35 U.S.C. § 102(b) as being anticipated by Wang, U.S. Patent Number 5,905,116 (hereinafter '116). Applicants respectfully traverse.

According to the Examiner, the '116 patent discloses gels derived from extending grafted α-olefin-maleimide centipede polymers and polypropylene. The Examiner further states that certain fillers such as metal oxides may be added to the gels. Applicants respectfully submit that the '116 patent does not teach the use of metal oxide fillers having a particle size less than about 15 μm (claims 1 and 18). Rather, the '116 patent teaches a long list of optional fillers. The '116 patent does not, however, teach the benefits that have been disclosed through use of the specific filler claimed in the present invention. Because the presently claimed compositions require a particle size that is not taught by the '116 patent, the '116 patent cannot be said to anticipate the present invention.

Claims 1, 4, and 7-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wang ('116). Applicants respectfully traverse.

According to the Examiner, it would have been obvious to follow the teachings of Wang and arrive at the claimed invention. The Examiner focuses on the particle size of the metal oxide fillers when making this rejection. Applicants respectfully submit that the claimed metal oxide particle size of claims 1 and 18 would not be obvious without undue experimentation. One of ordinary skill in the art would not, contrary to the Examiner's contention, find the metal oxide particle size of less than about 15 μm obvious, because it would not be obvious that such a particle size would lead to the lower shore A hardness claimed in claims 1 and 18, nor would it lead to the improved dynamic modulus and strain taught at page 11, lines 19-22.

Moreover, the list of additives taught in the '116 patent includes seven classes of additives and nine specific examples. Only through undue experimentation would one of ordinary skill in the art be able to not only narrow the list down to a specific class of additives, but also to a specific particle size within that class to achieve the desired characteristics of the present composition. Because the criticality of the claimed range is taught in the specification, and that criticality would not be obvious based on the

teachings of the '116 patent, Applicants respectfully submit that claims 1, 4, and 7-20 are not obvious over the '116 patent.

The Examiner has rejected claims 2 and 3 under 35 U.S.C. § 103(a) as being unpatentable over the '116 patent as applied to claim 1 and further in view of Wang, U.S. Patent Number 6,954,532 (hereinafter '532). Applicants respectfully traverse.

According to the Examiner, it would have been obvious to use one of the monomers of the '523 patent as a preferred monomer in lieu of the α-olefin in the poly(α-olefin-co-maleimide) of the '116 patent in order to impart enhanced elastomeric properties to the gel of the '116 patent. Applicants respectfully submit that even if the Examiner's proposed combination were obvious, it would not lead to the presently claimed polymer composition. The presently claimed composition includes metal oxide fillers having a particle size of less than about 15 μm. As previously discussed, the use of metal oxide fillers of a particular particle size would not be obvious to one of ordinary skill in the art and would only become apparent through the use of undue experimentation or forbidden hindsight, using the present specification as a roadmap. Claims 2 and 3 are thus not obvious over the '116 patent in view of the '532 patent.

Claim 6 is rejected under 35 U.S.C. § 103(a) as being unpatentable over the '116 patent as applied to claim 1 and further in view of Wang, U.S. Patent 6,350,800 (hereinafter '800). Applicants respectfully assert that this rejection is improper under 35 U.S.C. § 103(c). The '800 patent is a commonly assigned application that was copending with the present application. Accordingly, the '800 patent is only available as prior art under 35 U.S.C. § 102(e). Because it is only available under § 102(e), 35 U.S.C. § 103(c) states that it is ineligible for use as prior art under 35 U.S.C. § 103(a). The '800 patent is thus not prior art under 35 U.S.C. § 103(a) and Applicants respectfully submit that the rejection is improper. Withdrawal of the rejection is therefore requested.

The Examiner has rejected claim 5 under 35 U.S.C. § 103(a) as being unpatentable over the '116 patent in view of Wang, U.S. Patent Number 6,133,354 (hereinafter '354). Applicants respectfully traverse.

According to the Examiner, it would have been obvious to use the isobutylene in the polymer of the '116 patent in order to enhance the tensile strength and at the same

time enhance damping characteristics without need of a plasticizer. Applicants respectfully submit that combining the two references as suggested by the Examiner would not result in the composition of present claim 5. The proposed combination would not result in a composition including a metal oxide filler having a particle size of less than about 15 μm, such as that claimed in present claim 1. Moreover, neither the '116 nor the '354 patent teach or suggest the use of metal oxide fillers having the claimed particle size range. As previously discussed, the criticality of the claimed range is clearly taught in the present application and would not be obvious to one of ordinary skill in the art based on the teachings of either of the '116 or '354 patents. The use of the claimed range would only be obvious through the use of undue experimentation or prohibited hindsight using the present application as a roadmap. Claim 5 is not, therefore, obvious over the '116 patent in view of the '354 patent.

Applicants respectfully submit that in view of the above amendments and remarks, the present application is in condition for allowance. Withdrawal of the rejections and issuance of a Notice of Allowance is respectfully requested.

It is believed that no fees are due in conjunction with this amendment. If, however, it is determined that fees are due, authorization for deduction of those fees from Deposit Account number 06-0308 is hereby given.

Respectfully submitted,

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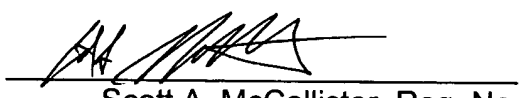

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